

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL BONAVENTURA, WAYNE A. BUTTERMORE,
DAVID J. CASH, and JOHN LEVIN

Appeal 2006-3285
Application 10/733,628
Technology Center 2800

Decided: February 12, 2007

Before KENNETH W. HAIRSTON, JOSEPH L. DIXON, and ALLEN R.
MACDONALD *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

First, we note that Appellants' Brief is non-compliant with respect to 37 C.F.R. 41.37(c)(1)(v) *Summary of claimed subject matter* with respect to each claim argued which contains means-plus-function limitations. With respect to dependent claim 6, Appellants state:

However, Fischer et al. do not disclose a stage insert with a releasable fastening means comprising a springed detent, rather, they disclose a spring means for controlling the spacing of the V-shaped plates to avoid inadvertent dropping of a specimen slide.

While Fischer et al. teach the use of springed detents, this structural feature lacks the "releasable" properties associated with Appellants' detent, and therefore, fails to meet the limitations of claim 6 (Br. 13).

Independent claim 1 recites:

1. A microscope stage comprising:

an upper stage comprising a first color; said upper stage comprising a recess therein; and

a non-transparent contrasting stage insert comprising a second color different from said first color; said non-transparent contrasting stage insert configured for removable complementarily receipt within said recess.

Dependent claims 4 and 6 further recite:

4. The microscope stage of Claim 1 wherein said non-transparent contrasting stage insert comprises releasable fastening *means*. [Emphasis added.]

6. The microscope of Claim 4 wherein said releasable fastening *means* comprises a springed detent. [Emphasis added.]

We note that Appellants' Brief is silent as to the corresponding structure acts or materials for performing function of the "releasable fastening means." Therefore, Appellants' Brief is non-compliant and a new brief is required. Therefore, the Examiner should require a new brief with a correct *Summary of the claimed subject matter* which identifies the corresponding structure acts or materials which correspond to the "releasable fastening means" recited in dependent claims 4 and 6. Appellants argue the releasable properties or the manner in which the function is performed.

As an additional note from our cursory review of Appellants' Specification, we note that the Specification seems to only describe "Figure 3 also illustrates that recess 32 further comprises fastening means 36 for securing the contrasting stage insert within the recess. Fastening means 36 may comprise magnets, hook and loop type fasteners, detents, springed ball bearings, or the like." Therefore, we find no structure to evaluate as to the "springed detent" corresponding to the "releasable fastener means." We leave it to the Examiner to further consider, after Appellants identify the corresponding structure, acts and materials in the Specification, whether this disclosure is sufficient under 35 U.S.C. § 112, First and Second Paragraphs.

The Examiner is required to take other appropriate action as needed.

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- (1) notify Appellants of the non-compliant Brief and require submission of a Brief in compliance with 37 C.F.R. 41.37;
- (2) consider Appellants' compliance with 35 U.S.C. § 112, First and Second Paragraphs, in light of the identification of corresponding structure; and
- (3) take such further action as may be appropriate.

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